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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,481	07/08/2003	Christophe Moinet	427.053-1	9254
47888	7590	10/19/2005	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			GRAZIER, NYEEMAH	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/615,481	<b>Applicant(s)</b> MOINET ET AL.	
	<b>Examiner</b> Nyeemah Grazier	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☒ Claim(s) 8,13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/24/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **I. ACTION SUMMARY**

Claims 8, 12-14 are currently pending. Claims 1-7, 10 and 11 have been cancelled. Claim 9 is withdrawn from further consideration by the Examiner because Claim 9 is drawn to a non-elected invention. 37 C.F.R. § 1.142(b).

### **II. PRIORITY**

This is a CIP of U.S. Non-Provisional Application 10/031,429 filed January 15, 2002, now U.S. Patent 6,727,269 which is a 371 of PCT/FR02/00093 filed January 11, 2002.

Acknowledgment is made of applicant's claim for foreign priority to French applications Serial Nos.: 01/00396, filed on January 12, 2001, 99/09496, filed on July 22, 1999, PCT/FR00/02095 filed July 21, 2000 under 35 U.S.C. 119(a)-(d). However, Applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

### **III. ELECTION/RESTRICTIONS**

#### ***Response to Election***

Examiner has acknowledged Applicant's election without traverse of Group I, claims 1-8 with traverse and provisional species election of the compound of Claim 13, in the Response to the Restriction Letter filed on August 18, 2005. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim that is remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Status of the Claims**

Claims 8, 12-14 are currently pending in the instant application. Claim 9 is withdrawn as said claims are drawn to non-elected subject matter. 37 C.F.R. § 1.142(b). The status of the claims is commensurate with the Amendment to the claims. Thus, the scope of the invention of the elected subject matter is as follows: **Claim 8, in part, drawn to the compound of formula (i) wherein:** R2 is phenyl or naphthyl as recited in Claim 12 (Amendment, pp. 2-9); and R5 is as described in Claim 12 (Amendment, pp. 2-9).

The withdrawn and or cancelled compounds as a result of the restriction various formulas representing divergent and distinct compounds. This recognized chemical diversity of the various formulas can be seen by the various classifications in the US classification system. For example, subgenus formula (i) is classified in 548/194, while subgenus formula (ii) is classified in 544/369 where R10 is piperazine, for example. Thus, the subject matter withdrawn from consideration as being non-elected subject matter differ materially in structure and composition and the fields of search are not co-extensive and therefore have been restricted properly.

## **IV. REJECTIONS**

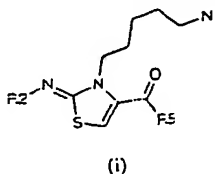
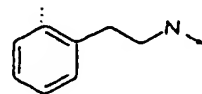
### **CLAIM REJECTIONS - 35 USC § 112, SECOND PARAGRAPH**

The following is a quotation of the *second paragraph* of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. First, Claim 12 is ambiguous because it recites the compound of formula (i)

and R<sub>5</sub> groups such as

which

contain nitrogen atoms without sufficient bonds or charges, is necessary. It appears that the nitrogen atom in Formula (i) could be NH<sub>2</sub> or perhaps a nitrile; and that the nitrogen atom in the R<sub>5</sub> groups are NH or NR or C=N-.

## V. OBJECTIONS

### Dependent Claim Objections

Dependent Claims 8, 13 and 14 are objected to as being dependent upon a rejected based claim. To overcome this objection, Applicant should rewrite said claims in an independent form and include the limitations of the base claim and any intervening claim.

### Claim Objections

Claim 9 is objected to because of the following informalities: A dependent claim must depend from a *preceding* claim. Appropriate correction is required.

### Objection to the Specification

The disclosure is objected to because of the following informalities: The disclosure teaches compounds drawn to various formulas and various “R” groups that depict nitrogen atom with one or two bonds. It is unclear whether the nitrogen atom is

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substituted with an "R" group, or is a nitrile or an NH group. Appropriate correction is required.

Also, the specification must include the continuity information after the title. This information is not provided in the Instant Application. Appropriate correction is required.

VI. CONCLUSION

CONCLUSION

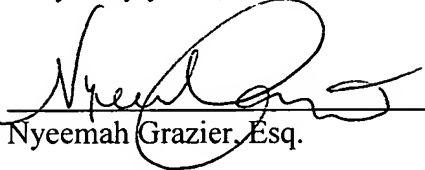
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Friday from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

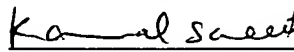
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Very truly yours,

  
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**PRIMARY EXAMINER**

  
for Joseph K. McKane  
Supervisory Primary Examiner, AU 1626